REMARKS

Status Of Application

Claims 1-10, 12-24, 26 and 27 are pending in the application; the status of the claims is as follows:

Claims 1, 2, 6, 7, 12-14, 20, 21, 26 and 27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,745,102 to Bloch et al. (hereinafter "Bloch") in view of U.S. Patent No. 5,937,107 to Kazami et al. (hereinafter "Kazami").

Claims 3-5, 8-10 and 22-24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bloch and Kazami, as applied to claims 1, 2, 6, 12-14, 20, 21 above, and further in view of U.S. Patent No. 5,731,861 to Hatano et al. (hereinafter "Hatano").

Claims 15 and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bloch and Kazami, as applied to claims 1, 2, 6, 7, 12-14, 20 and 21 above, and further in view of U.S. Patent No. 5,887,198 to Houlberg et al. (hereinafter "Houlberg").

Claim 17 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Bloch and Kazami, as applied to claim 6 above, and further in view of U.S. Patent No. 5,600,563 to Cannon et al. (hereinafter "Cannon").

Claims 18 and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bloch, Kazami and Cannon, as applied to claim 17 above, and further in view of U.S. Patent No. 4,200,390 to Tagashira et al. (hereinafter "Tagashira").

Drawings

To date, no Notice of Draftsperson's Patent Drawing Review has been received. Applicants respectfully request receipt of this document when it becomes available. Please note that the original drawings filed in the patent application are "formal" drawings.

35 U.S.C. § 103(a) Rejections

The rejection of claims 1, 2, 6, 7, 12-14, 20, 21, 26 and 27 under 35 U.S.C. § 103(a), as being unpatentable over Bloch, in view of Kazami; the rejection of claims 3-5, 8-10 and 22-24 under 35 U.S.C. § 103(a), as being unpatentable over Bloch and Kazami, as applied to claims 1, 2, 6, 12-14, 20 and 21 above; the rejection of claims 15 and 16 under 35 U.S.C. § 103(a), as being unpatentable over Bloch and Kazami, as applied to claims 1, 2, 6, 7, 12-14, 20 and 21 above, and further in view of Houlberg; the rejection of claim 17 under 35 U.S.C. § 103(a), as being unpatentable over Bloch and Kazami, as applied to claim 6 above, and further in view of Cannon; and the rejection of claims 18 and 19 under 35 U.S.C. § 103(a), as being unpatentable over Bloch, Kazami and Cannon, as applied to claim 17 above, and further in view of Tagashira, are respectfully traversed based on the following.

The Bloch patent shows an alphanumeric LCD display 122 integrated with a floppy disc 120. The LCD display is a seven segment or 5x7 dot matrix display that is only capable of displaying alpha numeric characters (column 4, lines 37-47). When the disc is inserted into the drive, a terminal strip 112 mates with connectors 212 in the drive. As files are written onto the floppy disc, the file names are stored in memory 114 for storage and display on the display. The Bloch patent does not show or suggest any display of information other than file names.

The Hatano patent describes a liquid crystal display material having a cholesteric phase at room temperature.

The Kazami patent shows an apparatus for digitizing images from developed photographic film. Film forwarding control circuit 23 advances developed film 23 to be captured by CCD image formation circuit 24. The resulting images are stored in image memory 27. In one function, CPU 26 converts the images stored in image memory 27 into thumbnail images so that thumbnail images of all of the stored images may be displayed on display device 29. Kazami does not provide any details on the display device 29.

The Houlberg patent shows a device for driving a PCMCIA memory card. It is stated that the device should include utilities for formatting the memory card (column 2, lines 18-21).

The Cannon patent shows a system for storing a plurality of greeting card descriptions, including images, on a CD-ROM 33 for distribution to card printing systems (Abstract).

The Tagashira patent shows a copier system where copy count setting dial 101 determines the number of copies to be made. The count down of producing those copies is displayed on display 132.

In contrast to the cited prior art, claim 1 includes:

> a driver which records the image data to the memory section of the storage medium and renews information and a display image displayed on the display section of the storage medium in accordance with the recorded image data while the storage medium is set in the receiving section.

In Applicants' prior response, it was noted that one skilled in the art would not be motivated to provide a display image, as taught by Kazami, for the display of Bloch because display 122 in Bloch is a twelve segment or 5x7 dot matrix alphanumeric display. The display in Bloch is not compatible with the display of images.

In the Office Action, it is stated that:

> Applicant mainly argues that none of the prior art of record teaches displaying the image data. However, Kazami et al clearly teaches (column 2, lines 49-63; fig. 1) that the driver records image data to the memory section (fig. 1, item 37) and writes a thumbnail image of the image data on the display section (fig. 1, items 28 and 29). One of ordinary skill in the art would have been motivated to do this because it would have provided a way of looking at several images at once which is what Kazami et al. intended, and displaying thumbnail image instead of the file name in the memory disk obviously provides more information about the files being stored to the user, but would require a bigger display section and slow down the operation of the system.

Applicants do not argue that the prior art does not teach the display of images. Applicants do argue that one skilled in the art would not try to display an image on an **alphanumeric display**, as in Bloch, **because that type of display cannot display images**. The principle of operation of the display 122 in Bloch is not compatible with the display of images (column 4, lines 37-47, column 6, lines 1-21).

> If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teaching of the references are not sufficient to render the claims *prima facie* obvious. MPEP §2143.01 (last paragraph).

The Office Action tacitly converts the display of Bloch from one that cannot display images to one that can. However, there is no explanation of this transformation and no suggestion in the references to make this transformation.

As stated in the MPEP §2143, the requirements of a *prima facie* case for obviousness:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.
>
> The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

There is no suggestion in the cited references to convert the display of Bloch from one that cannot display images to one that can. Because the display of Bloch can only display alphanumeric characters, there would have been no expectation that the images of Kazami could be successfully displayed on the display of Bloch.

Therefore, the cited prior art does not comprise a *prima facie* case for obviousness and claim 1 is patentably distinct from the cited prior art. Claims 2-5 are dependent upon claim 1. If an independent claim is nonobvious, then claims that depend from that claim

are also nonobvious. MPEP §2143.03. Therefore, claim 1-5 are patentably distinct from the cited prior art.

Also in contrast to the cited prior art, claim 6 includes,

> a driver which records the image data processed by the data processing section to the memory section of the storage medium and renews information and a display image displayed on the display section of the storage medium in accordance with the recorded image data while the storage medium is set in the receiving section.

As explained above with regard to claim 1, this combination of limitations is not suggested by the cited prior art. Therefore, claim 6 is patentably distinct from the cited prior art. Claims 7-10, 12-19 are dependent upon claim 6. If an independent claim is nonobvious, then claims that depend from that claim are also nonobvious. Therefore, claim 7-10, 12-19 are patentably distinct from the cited prior art.

Also in contrast to the cited prior art, claim 20 includes,

> a storage medium which has a memory section to be stored with image data and a display section to display information and the image data; and
> ...
> a driver which records the image data processed by the data processing unit to the memory section of the storage medium and renews information and a display image on the display section of the storage medium in accordance with the image data.

As explained above with regard to claim 1, this combination of limitations is not suggested by the cited prior art. Therefore, claim 20 is patentably distinct from the cited prior art. Claims 21-24, 26 and 27 are dependent upon claim 20. If an independent claim is nonobvious, then claims that depend from that claim are also nonobvious. Therefore, claim 21-24, 26 and 27 are patentably distinct from the cited prior art.

Accordingly, it is respectfully requested that the rejection of claims 1-10, 12-24, 26 and 27 under 35 U.S.C. § 102(b) as being anticipated by Bloch or under 35 U.S.C.

§ 103(a) as being unpatentable over Bloch and in view of Hatano, Kazami, Houlberg, Tagashira and Cannon, be reconsidered and withdrawn.

CONCLUSION

Wherefore, in view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are earnestly solicited.

This Response does not increase the number of independent claims, does not increase the total number of claims, and does not present any multiple dependency claims. Accordingly, no fee based on the number or type of claims is currently due. However, if a fee, other than the issue fee, is due, please charge this fee to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260.

Any fee required by this document other than the issue fee, and not submitted herewith should be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260. Any refund should be credited to the same account.

If an extension of time is required to enable this document to be timely filed and there is no separate Petition for Extension of Time filed herewith, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed.

Any other fee required for such Petition for Extension of Time and any other fee required by this document pursuant to 37 C.F.R. §§ 1.16 and 1.17, other than the issue fee,

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Respectfully submitted,

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